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| 09/894,628      | 06/28/2001  | Susumu Nakagawa      | 450100-03297        | 6151             |

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| EXAMINER |
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GREENE, DANIEL L

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| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/894,628

**Applicant(s)**

NAKAGAWA, SUSUMU

**Examiner**

Daniel L. Greene

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 12/3/2005 have been fully considered but they are not persuasive. The Applicant submits that comparing said content usage rights information (usage limit) with status code information showing the usage status of said contents (number of uses), determining whether the contents are used within the range set by said content usage rights information (is the usage below the usage limit), outputting said warning report data when said status code information exceeds said output setting information (notifying the user they have met the usage limit). The Examiner submits that the prior art is about "rights management" that includes the types and kinds of usage that includes limits of usage by number of times or periods of times or length of times a digital works can be used. It is obvious to a person of ordinary skill in the art at the time of the invention was made to have set limits on the usage of the digital works and the means to track and compare the usage to a limit and when the limit is reached, initiate an action to prevent the further use of the digital works and/or provide the user with the information/means to continue accessing the information. The previous and following Office Action specifies the relevant sections of the prior art that addresses the Applicant's claims.

A reference is to be considered not only for what it expressly states, but for what it would reasonably have suggested to one of ordinary skill in the art. *In re DeLisle*, 160 USPQ 806 (CCPA 1969). The Examiner submits that the prior art, Ginter, discloses the

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rights management procedures claimed by the Applicant by his section on "track of events" and the "meter process".

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al, US Patent Publication 2003/0163431 A1. [Ginter]

As per claims 1, and 7-9:

The recitation that "A contents control method ...", "A content control apparatus ...", "A contents control device ...", and "A program storage medium ..." has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a method, a system, an apparatus, etc. and the portion of the claim following the preamble is a self-contained description of the method or the system, etc., not depending for completeness upon the introductory clause.

*Kropa v. Robie*, 88 USPQ 478 (CCPA 1951)

Ginter discloses

comparing said content usage rights information with status code information showing the usage status of said contents (Abstract; Brief Summary; Background and Summary of the Invention; Fig 1-1A, 3-5B; 8-10; associated text).

Ginter does not explicitly recite determining whether the contents are used within the range set by said content usage rights information, comparing said status code information with output setting information having a threshold value within the range of said contents usage rights information to warn by warning report data when in proximity to said contents usage rights in the case where said status code information is within the range of said contents usage rights information, and outputting said warning report data when said status code information exceeds said output setting information.

However Ginter does teach that his system has the capability to perform user "pop-up dialog windows" that will warn users of certain events and conditions related to their use of controlled content. Par. 1054, 2070-2073, 2078, Col. 262-264, lines 1-67.. "Alarms" may be set up using these windows to notify the user of approaching budget limits, i.e. time allowed for using a protected content, number of copies allowed, etc. Therefore it would have been obvious for one ordinarily skilled in the art at the time the invention was made to include such warning features in Ginter's system, in order to forewarn potential users of the pending completion of their access to controlled content, so that the users may elect to extend their access, or plan their continued use of the content accordingly. Such a feature would make the system more attractive to users and would add to the system's popularity.

Also, it would be obvious to a person of ordinary skill in the art at the time of the invention was made to have set limits on the usage of the digital works and the means to track and compare the usage to a limit and when the limit is reached, initiate an

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action to prevent the further use of the digital works and/or provide the user with the information/means to continue accessing the information.

As per claim 2:

Ginter further discloses:

... status code information reaches the contents usage information, usage of said contents is prohibited and invalidation report data is outputted, reporting that use of said contents has been prohibited. Col. 142, lines 1-25, Col. 155, lines 37-67.

As per claim 3:

Ginter does not specifically recite

... a deletion elapse time for setting a period from prohibiting usage of said contents to deletion of said contents is set in said output setting information, and when the period from prohibiting usage of said contents to said deletion elapse time is reached, said contents are deleted and deletion report data is outputted to report said contents have been deleted.

However Ginter does teach that his system has the capability of causing protected content to be modified or deleted automatically, depending on the needs and authority of the content author or distributor, and according with the usage rights granted to individual users for the access to such content (Par. 2234-2238, 2255). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have included the limitations of claim 3 into a system based on Ginter, in order to further protect

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copyrighted content after their access has expired by automatically deleting the content, thus negating any possibility for future access.

As per claim 4:

Ginter further discloses:

... loading period information set with the loading timing for loading said contents usage right information, said status code information and said output setting information are set in said setting information, and said status code information, said contents usage information and said setting information are compared based on said loading interval information. Col. 151-152, lines 1-67.

As per claim 5:

Ginter further discloses:

... warning report data, said invalidation report data and said deletion report data are respectively outputted to screen display means. Col. 143, lines 1-26, Fig 7, associated text.

As per claim 6:

Ginter further discloses:

... said warning report data, said invalidation report data and said deletion report data are respectively outputted as electronic mail. Col. 262, lines 40-67, Fig 7; associated text)

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Daniel L. Greene  
Examiner  
Art Unit 3621

1/25/2005